

REMARKS

The Advisory Action dated August 16, 2005, has been received and carefully considered. In this response, claims 1, 3, 8, 10, 16, and 18 have been amended, claims 53-55 have been added, and claims 2, 9, and 17 have been cancelled without prejudice. Entry of the amendments claims 1, 3, 8, 10, 16, and 18, the addition of claims 53-55, and the cancellation of claims 2, 9, and 17 without prejudice is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

At the outset, Applicants note with appreciation the indication on pages 1-2 of the Advisory Action that claims 2-4, 9-11, and 17-22 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1, 8, and 16 have been substantially amended in this manner by incorporating therein the limitations of claims 2, 9, and 17, respectively. Also, newly added claim 53 combines the limitations of claims 1 and 4. Accordingly, these claims should now be allowable. Acknowledgment of same is respectfully requested.

I. THE OBVIOUSNESS REJECTION OF CLAIMS 1, 8, AND 16

On pages 1-2 of the Advisory Action, the rejection of claims 1, 8, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Goldrian (U.S. Patent No. 5,742,798) was maintained. This rejection is hereby respectfully traversed with amendment.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill

in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Regarding claims 1, 8, and 16, the Examiner asserts that Applicants' arguments in the Response on filed August 2, 2005,

are not persuasive for various reasons. The Examiner also characterizes certain aspects of the present application. The Examiner further asserts that Goldrian discloses the claimed invention.

Applicants respectfully disagree with the Examiner's assertions regarding Applicants' arguments in the Response on filed August 2, 2005, as well as the Examiner's assertions that Goldrian discloses the claimed invention. Applicants also disagree with the Examiner's characterization of certain aspects of the present application. However, in order to expedite allowance of the present application, Applicants have amended claims 1, 8, and 16 to incorporate therein the limitations of claims 2, 9, and 17, respectively. Also, Applicants have added new independent claim 53, which combines the limitations of claims 1 and 4. Since the Examiner has acknowledged that claims 2, 4, 9, and 17 contain allowable subject matter, claims 1, 8, 16, and 53 should now be allowable. Acknowledgment of same is respectfully requested.

Each of claims 3, 10, 11, 18-22, 54, and 55 are dependent upon one of independent claims 1, 8, 16, or 53. Thus, since independent claims 1, 8, 16, and 53 should be allowable as discussed above, claims 3, 10, 11, 18-22, 54, and 55 should also be allowable at least by virtue of their dependency on

independent claims 1, 8, 16, and 53.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1, 8, and 16 be withdrawn.

II. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

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